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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/477,936	01/05/2000	HARRY E. EMERSON	17617-46	9952

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 04/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/477,936

Applicant(s)
Emerson et al

Examiner
James W. Myhre

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2162



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 12, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. The amendment filed on February 12, 2002 has been considered but is ineffective to overcome the Chen et al (5,917,830) and Capek et al (6,094,677) references. The amendment added new Claims 10-12. Therefore, the currently pending claims considered in this office action are Claims 1-12.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al (5,917,830) in view of Capek et al (6,094,677).

Claims 1 and 7: Chen discloses a system and method for substituting advertisements during a broadcast, comprising:

- a. Generating, digitizing, and storing a plurality of replacement commercials (e.g. advertisements) for insertion into the broadcast (col 4, lines 39-41 and col 13, lines 15-20);

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- b. Marking the broadcast with the start and end times (e.g. duration) of the commercial (col 2, lines 18-21; col 6, line 66 - col 7, line 10; and col 13, lines 15-20);
- c. Receive the broadcast (col 13, lines 57-62);
- d. Detect and read the insertion marker on the broadcast (col 6, lines 1-10 and col 12, lines 36-37);
- e. Select and substitute (insert) a replacement commercial into the broadcast at a point corresponding to the insertion marker (col 8, lines 1-5 and col 14, lines 3-12); and
- f. Repeat the detection and insertion of replacement commercials throughout the broadcast (col 13, line 61 - col 14, line 7).

While Chen uses a network television broadcast as an exemplary use of the invention, it is also disclosed that the invention can be applied "for splicing a secondary packetized data stream, such as a commercial, with a primary packetized data stream" (col 4, lines 7-9) and that the secondary packetized data streams (commercials) being inserted (spliced) "may include digital audio tapes" or "compact audio discs (CDS)" (col 4, lines 39-43) and that "audio only or data only messages may be inserted into the main packetized data stream" (col 4, lines 57-59). The Applicant's invention is directed to inserting a replacement commercial into a radio broadcast being received via the Internet. The Examiner notes that both radio and television broadcasts may be received via the Internet, and that both are "packetized data streams". Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that the packetized data stream into which Chen is inserting commercials could contain either

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audio/video data (i.e. television) or only audio data (i.e. radio). One would have been motivated to use Chen's system and method to insert commercials into a radio broadcast in view of his disclosure of inserting audio only data and storing digital audio tapes.

Chen discloses replacing main stream commercials with the selected commercials (col 14, lines 7-12) and also discloses marking and detecting the start and end times of the insertion points (T_{in} and T_{out} ; col 13, lines 15-20). Additionally, Chen discloses that "the system should avoid any discontinuity which results in a non-compliant data stream. The data stream should also preclude problems such as syntax violations, decoding errors, buffer overflow or underflow, timing recovery problems due to discontinuous time stamps, audio/video synchronization problems, and video display artifacts" (col 1, line 65- col 2, line 3). While it is not explicitly disclosed that a comparison is made to determine whether the duration of the replacement commercial corresponds to the duration of the main stream commercial being replaced (based on the start and end times), it is inferred that such a comparison is being made in order to "avoid discontinuity" and "buffer overflow or underflow". Capek discloses a similar system and method for inserting commercials into data streams containing content information which also determines whether the duration of the insertion point is sufficiently long to allow insertion of a commercial (col 4, lines 43-51; col 5, lines 23-28; and col 9, lines 57-61). This infers that the duration of each stored replacement commercial is known and used in the determination (comparison). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to compare the durations of the main stream commercial and the replacement commercial

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when selecting the replacement commercial in the Chen invention. One would have been motivated to compare these durations in order to decrease the likelihood of “blank time” during the reception of the broadcast if the replacement commercial was shorter than the main stream commercial or “overwriting” of the main stream broadcast (content) if the replacement commercial was longer than the main stream commercial.

Claim 2: Chen and Capek disclose a method and system for substituting advertisements during a broadcast as in Claim 1 above. Chen also discloses that the marking of the start and end times of the insertion point is performed by the broadcast station (col 6, line 66 - col 7, line 10 and col 13, lines 15-20).

Claim 3: Chen and Capek disclose a method and system for substituting advertisements during a broadcast as in Claim 2 above. Both references also disclose digitizing the audio stream into sequential packets to allow for presenting a series of packets in the proper order as one complete commercial (Chen, Fig. 6a, items A1-A11 and col 14, lines 56-65)(Capek, col 5, lines 14-16; col 7, lines 42-47; and col 8, line 59 - col 9, line 5).

Claims 4-6, 8, and 9: Chen and Capek disclose a method and system for substituting advertisements during a broadcast as in Claims 1, 2, 3, and 7 above. While Chen does not explicitly disclose using consumer demographics to select (target) the replacement commercial, Capek discloses that the information “may be customized to either the user or the material requested, or both” (col 4, lines 43-51 and col 8, lines 7-58) and that “the insertion manager 20 then selects a customized insertion based upon the client profile for the requesting client” (col 12,

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lines 32-39), or type of information requested (col 12, lines 34-39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base the selection of the commercials in Chen upon the consumer's demographic information. One would have been motivated to use this type of selection in Chen in order to present commercials which are more pertinent to the consumer ("to increase the users interest and to make the information more engaging", Capek, col 7, lines 8-10), thus increasing the acceptance and interaction with the commercial by the consumer.

Claim 10: Chen and Capek disclose a method for substituting advertisements during a broadcast which performs steps (a) - (m) of Claim 1 and further performs the steps in which consumer demographic data and advertisement type information are stored and used to select the replacement advertisement as in Claims 4 and 5 above.

Claim 11: Chen and Capek disclose a method for substituting advertisements during a broadcast as in Claim 10 above. Chen further discloses that the marking of the start and end times of the insertion point is performed by the broadcast station as in Claim 2 above (col 6, line 66 - col 7, line 10 and col 13, lines 15-20).

Claim 12: Chen and Capek disclose a method for substituting advertisement during a broadcast as in Claim 11 above. Both references also disclose digitizing the audio stream into sequential packets to allow for presenting a series of packets in the proper order as one complete commercial as in Claim 3 above (Chen, Fig 6a, items A1-A11 and col 14, lines 56-65)(Capek, col 5, lines 14-16; col 7, lines 42-47; and col 8, line 59 - col 9, line 5).

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Response to Arguments

4. Applicant's arguments filed February 12, 2002 have been fully considered but they are not persuasive.

a. The Applicant argues that Capek does not replace program content with substitute content, but merely "contemplates addition material inserted into gaps in the data stream being received". The Examiner notes that Capek has been used to support Chen's inferred disclosure of tracking the start and end times (duration) of the advertising opportunity (Claims 1, 7, and 10) and to support the obviousness of targeting the advertisements based on consumer demographics and/or advertisement type (Claims 4-6 and 8-10). Capek's invention of inserting advertisements into a digitized data stream renders it analogous art to Chen's invention of inserting replacement advertisements into a digitized data stream. As such, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use Capek's method for targeting the selected advertisements based on the consumer's demographics or the advertisement type to select the replacement advertisements Chen is inserting into the digitized data stream. The Examiner also notes that several of the other references cited by the Examiner during the previous office action (paper no. 10) and references cited by the Applicant on the Information Disclosure Statement (paper no. 2) filed on April 7, 2000 also disclose the widespread use of consumer demographics to select (target) advertisements being presented to the consumer (e.g. Montero, Lowe, Shane, Goldhaber, and Logan).

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b. The Applicant argues that “any method practiced in light of the combined teachings of the cited references must include the Capek et al insertion step”. The Examiner is uncertain why the Applicant asserts that if the references were combined that the insertion method of Chen must be replaced with the insertion method of Capek, while not also asserting the necessity to replace the method Chen uses to select the replacement advertisement with Capek’s method based on consumer demographics or advertisement type. When two or more references are used to reject a claim, it is inherent that some of the claimed features will be disclosed by one of the references and some of the claimed features (which may overlap with the ones in the first reference) will be disclosed by the other reference(s). As long as there is motivation to combine the references (i.e. analogous art), it is proper and obvious for a practitioner to select the most desirable features in each reference. This is the basis for a 35 U.S.C. 103 rejection of obviousness. In this light, it would have been obvious to use Capek’s targeted advertisement selection method to determine which replacement advertisements to insert into the digitized data stream in Chen. As the Applicant pointed out, it would not have been obvious to replace Chen’s replacement method with Capek’s insertion method, since this would render the invention inoperable.

c. The Applicant argues in reference to the tracking of the duration of the replacement advertisement. This feature has been further expounded upon in the rejection of Claims 1, 7, and 10 above, which shows the inference by Chen of this feature.

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d. The Applicant argues that a random insertion of advertisements into a radio broadcast would disrupt the broadcast and cause “undesirable intrusions”. As the Applicant points out, “creators of broadcast program content generally schedule commercial breaks with great care”; that the “contractual relationship” (between an advertiser and a broadcaster) “likely includes scheduling considerations”; and that “conventional broadcast schedule includes advertisements, the number and duration of which are pre-determined by the originating radio station.” Since Chen is tracking the start and end times of the broadcast advertisements and replacing them with selected replacement advertisements, it is inferred that the replacement would not be “random” as asserted by the Applicant, but would coincide with the scheduled commercial breaks in both number and duration.

e. The Applicant argues in reference to Claims 4-6, 8, and 9 that Chen does not disclose and cannot use “customer demographics in the selection of the replacement commercial”. The Examiner notes that this feature has been further expounded upon in the rejection of these claims in paragraph 3 above and in the discussion in paragraph 4b above. In Figure 1, Chen discloses that in addition to the receiver being consumer television sets (items 170 and 172), the receiver could also be a consumer person computer (PC)(item 174). Thus, the Applicant’s final argument in reference to the inability to target specific consumer’s on a cable television network only applies to one embodiment of the Chen invention and is, therefore, non-persuasive.

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Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal of Official faxes to Technology Center 2100 is (703) 746-7239 or 7238. Draft or Informal faxes for this Art Unit can be submitted to (703) 746-7240. Draft faxes may also be submitted directly to the examiner at (703) 746-5544.

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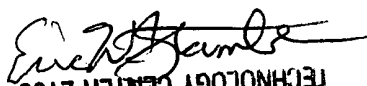
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-3900.


JWM

April 4, 2002


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